

REMARKS

The above amendments to the above-captioned application along with the following remarks are being submitted as a full and complete response to the Official Action dated March 26, 2004. In view of the above amendments and the following remarks, the Examiner is respectfully requested to give due reconsideration to this application, to indicate the allowability of the claims, and to pass this case to issue.

Status of the Claims

Claims 2-32 are under consideration in this application. Claims 30-32 are being amended, as set forth above in the marked-up presentation of the claim amendments, in order to more particularly define and distinctly claim Applicants' invention.

Additional Amendments

The claims are being amended to correct formal errors and/or to better disclose or describe the features of the present invention as claimed. Applicants hereby submit that no new matter is being introduced into the application through the submission of this response.

Formality Rejections

Claim 32 was rejected under 35 U.S.C. § 101 due to the claiming of the non-statutory subject matter. As the claim is being amended as suggested by the Examiner, the withdrawal of the outstanding claim objections is in order, and is therefore respectfully solicited.

Prior Art Rejection

Claims 3-5, 7-8 and 17-32 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. No. 6,514,081 to Mengoli (hereinafter "Mengoli") and in view of U.S. Pat. No. 6,514,080 to Ishida (hereinafter "Ishida"). Furthermore, claims 20-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mengoli and in view of Ishida, claims 9, 11-13 and 15-16 were rejected as being unpatentable over Mengoli and in view of Ishida and further in view of U.S. Pat. No. 6,183,259 to Macri et al. (hereinafter "Macri"), and claims 2, 6, 10 and 14 were rejected as being unpatentable over Mengoli in view of Ishida and further in view of U.S. Pat.

No. 6,152,856 to Studor et al. (hereinafter "Studor"). These rejections have been carefully considered, but are most respectfully traversed.

The instructional method for a sport, a hobby, an amusement game or a daily activity according to the invention, as now recited in claim 30, comprises: displaying a main heading section of a plurality of basic examples of problem points (e.g., I in Fig. 2); displaying a concrete subheading section (e.g., II in Fig. 2) as clicked by a learner on one of the basic examples of problem points; displaying a question form (e.g., Fig. 5) on demand ("*by clicking the so-called (HELP) button*" p. 11, last line) and analyzing entries by the learner addressed to the question form so as to determine a concrete problem of the learner; providing an electronic means for recording, editing and searching one improved performance image of an instructor corresponding the clicked or determined concrete problem point; and displaying said improved performance image of an instructor. The electronic means displays the main heading section, the subheading section, the question form including a screen page (p. 7 in Fig. 5) of a plurality image pairs each corresponding to one of clicked likely problem points (e.g., grip, set up, alignment, ball position; "likely cause of error"), each of the image pairs including an actual performance image of the learner and an improved performance images of an instructor ("** from hereon the 'two screen software' instructional system using comparison is used*" Fig. 5 between p.6 and p. 7), a performance image corresponding to the clicked or determined concrete problem point, the improved performance image of an instructor, the clicked or determined concrete problem point, and at least one method for overcoming the clicked or determined concrete problem point, and said method is presented in at least one of diagrammatic representation, letters, and speech sound. The clicked or determined concrete problem point is a concrete problem of the learner in actually practicing said sport, hobby, an amusement game or a daily activity ("*individual problem point*" page 5, lines 5-6; "*his/her problem point*" page 10, 3rd paragraph; "*the learners themselves are not aware of their own problem points and they cannot comprehend where the problem is with their form.*" page 11, last paragraph).

The *self-diagnosis analysis* question form of the invention includes such a unique screen page which displays a plurality of actual performance image pairs of the learner and the instructor corresponding to clicked likely problem points side by side to assist the learner to visually identify the most likely cause of error out of the likely causes of error (e.g., grip, set up, alignment, ball position) so as to determine a concrete problem of the learner in *actually practicing* said sport, hobby, an amusement game or a daily activity. The screen page is crucial

when “*the learners themselves are not aware of their own problem points and they cannot comprehend where the problem is with their form* (p.12, 3rd paragraph).”

The invention is also directed to a system (claim 31) or a software (claim 32) executing the method recited in claim 30.

Applicants respectfully contend that neither Mengoli nor any other cited prior art reference, teaches or suggests an instructional method which “displays a question form on demand and analyzing entries by the learner addressed to the question form so as to determine a concrete problem of the learner, while the question form containing a screen page which displays a plurality of actual performance image pairs of the learner and the instructor corresponding to clicked likely problem points side by side” as does the invention.

As admitted by the Examiner (p. 4, lines 1-3), Mengoli does not disclose a system or method of instruction for a sport improvement activity wherein a question form is displayed and entries are analyzed to determine a concrete problem of the learner. Mengoli further fails to teach or suggest any screen page which displays a plurality of actual performance image pairs of the learner and the instructor corresponding to clicked likely problem points side by side.

Fig. 6 of Ishida was relied upon by the Examiner to make the question form of the invention appear to be obvious. However, Fig. 6 merely shows “repetition of a test (col. 2, line 40).” Ishida’s test for a c-card is essentially different form the self-diagnosis analysis question form for determining a concrete problem of the learner’s *actually practicing act* of a sport etc. of the invention.

As shown in Fig. 5, Ishida’s test merely ask questions regarding the testee’s **knowledge** regarding the bouyancy-crotrol procedure for scuba diving, such knowledge does not involve any actual scuba diving practice of the tester (“*The skill up system judges the level of the member through the noticed content from the member, and issues an instruction to proceed to a next stage if the level is sufficient, or an instruction to take the same content if not* (col. 4, lines 10-13).” A person’s knowledge of how to do a sport does not equate to how the person actually does or practices the sport. Ishida only alleges that it can test and find out a testee’s “skill level” without providing sufficient disclosure to enable one skilled in the art to realize such a goal.

Ishida’s knowledge test is standard and does not includes any personal actual performance images as does the invention such that it simply cannot determine a concrete problem of the learner’s ***actually practicing act*** of a sport based upon such a knowledge test. In

addition, Ishida's knowledge test does not contain any screen page which displays a plurality of actual performance image pairs of the learner and the instructor corresponding to clicked likely problem points side by side.

The Examiner's analogy between "Ishida's **knowledge** test" and "the invention's question form for determining a concrete and actual practicing problem of the learner's *actually practicing act* of a sport " is questionable **in the absence of any concrete evidence in the record to support the analogy.**

"It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. Zurko, 258 F.3d at 1385, 59 USPQ2d at 1697 ("[T]he Board cannot simply reach conclusions based on its own understanding or experience-or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings."). While the court explained that, "as an administrative tribunal the Board clearly has expertise in the subject matter over which it exercises jurisdiction," it made clear that such "expertise may provide sufficient support for conclusions [only] as to peripheral issues." Id. at 1385-86, 59 USPQ2d at 1697. As the court held in Zurko, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. Id. at 1385, 59 USPQ2d at 1697. See also In re Lee, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002) (In reversing the Board's decision, the court stated " 'common knowledge and common sense' on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency's obligation.. The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies."). " As such, the Examiner must provide "some concrete evidence in the record in support of" factual assertion to rely solely on "common knowledge" in the art as the principal evidence.

Macri and Studor fail to compensate for the above-discussed deficiencies. Macri's cues (col., lines 64-67; col. 10, lines 1-10) only concerns what a player (even an handicapped person in Fig. 25) *wishes* to see in the simulation, rather than any actual practice. Studor merely varies the resistance setting of indoor exercise equipment (Fig. 1) in order to simulate varying degrees of difficulty. Studor has nothing to do with any actual practice of sports, etc. or any problems of the user in actually practicing such sports. Macri and Studor further fail to teach or suggest any

screen page which displays a plurality of actual performance image pairs of the learner and the instructor corresponding to clicked likely problem points side by side.

Although the invention displays a pair of an actual performance image of a learner and one of an instructor side-by-side as in the prior art, the invention displays several pairs of the images corresponding to clicked likely problem points side by side to provide unexpected results. For example, to assist the learner to visually identify the **most** likely cause of error (i.e., a concrete problem of the learner in *actually practicing*) out of several likely causes of error. The presence of the unexpected properties is evidence of nonobviousness. MPEP§716.02(a).

"Presence of a property not possessed by the prior art is evidence of nonobviousness. In re Papesch, 315 F.2d 381, 137 USPQ 43 (CCPA 1963) (rejection of claims to compound structurally similar to the prior art compound was reversed because claimed compound unexpectedly possessed anti-inflammatory properties not possessed by the prior art compound); Ex parte Thumm, 132 USPQ 66 (Bd. App. 1961) (Appellant showed that the claimed range of ethylene diamine was effective for the purpose of producing " 'regenerated cellulose consisting substantially entirely of skin' " whereas the prior art warned "this compound has 'practically no effect.' ").

The unexpected properties were unknown and non-inherent functions in the prior art, since the prior art does not inherently achieve the same results. In other words, these advantages would not flow naturally from following the teachings of the prior art, since the prior art fails to suggest applying a question form containing a screen page which displays a plurality of actual performance image pairs of the learner and the instructor corresponding to clicked likely problem points side by side.

Applicants further contend that the mere fact that one of skill in the art could rearrange a prior art question form to meet the terms of the claims is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for one skilled in the art to provide the unexpected properties, such as to assist the learner to visually identify the **most** likely cause of error (i.e., a concrete problem of the learner in *actually practicing*) out of several likely causes of error, without the benefit of appellant's specification, to make the necessary changes in the reference device. *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). MPEP§2144.04 VI C.

Accordingly, the present invention as now recited in the independent claims 30, 31 and 32 is distinguishable and thereby allowable over the rejections raised in the Office Action. The withdrawal of the outstanding prior art rejections is in order, and is respectfully solicited.

Conclusion

In view of all the above, clear and distinct differences as discussed exist between the present invention as now claimed and the prior art reference upon which the rejections in the Office Action rely, Applicant respectfully contends that the prior art references cannot anticipate the present invention or render the present invention obvious. Rather, the present invention as a whole is distinguishable, and thereby allowable over the prior art.

Favorable reconsideration of this application is respectfully solicited. Should there be any outstanding issues requiring discussion that would further the prosecution and allowance of the above-captioned application, the Examiner is invited to contact the Applicant's undersigned representative at the address and phone number indicated below.

Respectfully submitted,

Stanley P. Fisher
Registration Number 24,344



Juan Carlos A. Marquez
Registration Number 34,072

REED SMITH LLP
3110 Fairview Park Drive, Suite 1400
Falls Church, Virginia 22042
(703) 641-4200

September 27, 2004

SPF/JCM/JT